

## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed December 24, 2008. Through this response, claims 5-18, 23, 27-30, 32-34, 36-38, 40-51, 56, 57, and 97 have been amended. Applicant respectfully requests entry of the amendments herein and reconsideration of all pending claims.

### **I. Claim Rejections - 35 U.S.C. § 112, 2<sup>nd</sup> Para.**

Claims 5-18, 23, 24, 27-39, 40-44, 46-48, 57, and 97 have been rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. Applicant has amended the above-listed claims, and believes the rejection to be rendered moot.

### **II. Claim Rejections - 35 U.S.C. § 103(a)**

#### **A. Statement of the Rejection**

Claims 5-14, 16-20, 39-47, 95-101, and 129 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Payton* (U.S. 5,790,935) in view of *Norwood* (U.S. 5,983,316), *Tsukidate et al.* ("*Tsukidate*," U.S. 6,507,950), *Schein et al.* ("*Schein*," U.S. 6,002,394), and *Ellis et al.* ("*Ellis*," U.S. 6,928,653).

Claims 49-51 and 53-57 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Payton*, *Norwood*, *Tsukidate*, *Schein*, and *Ellis*, and further in view of *Dougherty et al.* ("*Dougherty*," U.S. 7,028,327).

Claims 15, 23-30, 32-38, and 48 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Payton*, *Norwood*, *Tsukidate*, *Schein*, and *Ellis*, and further in view of *Daniels* (U.S. 6,973,669).

Claim 130 has been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Tsukidate* in view of *Norwood*.

Applicants respectfully traverse these rejections.

## **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

For a proper rejection of the claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements / features of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d. 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that a *prima facie* case of obviousness is not established using the art of record.

Claims 5-14, 16-20, 39-47, 95-101, and 129 – *Payton, Norwood, Tsukidate, Schein, and Ellis*

### **Independent Claim 39**

Claim 39 recites (with emphasis added):

39. A digital home communication terminal (DHCT) comprising:  
a memory that stores executable instruction sequences; and  
a processor that executes the stored executable instruction sequences,  
the stored executable instruction sequences including:  
***an electronic programming guide (EPG) application that  
provides user access to EPG information;***

***a dual mode file system that provides a common interface to both a local storage device and a remotely located storage device;***

***wherein the EPG application further includes:***

instructions that determine whether a local storage device is coupled to the DHCT;

***instructions that use the dual mode file system to retrieve the EPG information from the remotely located storage device and store the EPG information in the memory, responsive to determining that the local storage device is not coupled to the DHCT;***

***instructions that use the dual mode file system to retrieve the EPG information from the remotely located storage device and store the EPG information in the local storage device, responsive to determining that the local storage device is coupled to the DHCT;***

wherein the electronic programming guide information includes a list of media content instances for a standard amount of days, a list of media content instances for an extended amount of days, channels for the media content instances, standard description information for the media content instances, long description information for the media content instances, and media content instance preview ***audio*** and video ***clips***.

Applicant respectfully submits that *Payton* in view of *Norwood*, *Tsukidate*, *Schein*, and *Ellis* fails to disclose, teach, or suggest at least the above-emphasized features. The Office Action (page 4) alleges that *Payton* discloses in col. 6, lines 20-36 an EPG application that provides user access to EPG information. Applicant respectfully disagrees. *Payton* appears to disclose on demand systems (see, e.g., col. 1, lines 38-42, *Payton*). Presumably the Office is referring to the lists 44, but such a list is not disclosed as an ***EPG application***, and more reasonably refers to on demand content. For at least this reason, Applicant respectfully requests that the rejection be withdrawn.

Additionally, the Office Action (page 4) alleges that the claimed ***dual mode file system*** is disclosed in col. 7, lines 13-20 and lines 47-55 of *Payton*). Applicant respectfully disagrees. The Office presumably is referring to the local server 28 as the claimed ***dual mode file system***, but such a construction is misplaced, since claim 39 recites a ***DHCT*** (which the Office has equated to the server 28), and the claimed DHCT comprises various components, including the claimed ***dual mode file system***. The server 28 cannot be both. Accordingly, Applicant respectfully requests that the rejection be withdrawn for this additional reason. Alternatively, if

Applicant has not accurately determined which component the Office action is equating to the claimed **dual mode file system**, Applicant respectfully requests that the next Office Action specify with particularity which component is being equated to the **dual mode file system**. It is respectfully submitted that it is not inherent that the same component in the server 28 is performing both functions.

Further, since there is no EPG information disclosed in *Payton*, it cannot be accurately asserted that EPG information is presented, and accordingly, Applicant respectfully requests that the rejection be withdrawn for this additional reason.

The Office Action (page 4) acknowledges the deficiencies of *Payton*, but alleges that these deficiencies are remedies by the other references. Applicant respectfully disagrees. For instance, *Norwood* is cited as analogous art. Applicant respectfully disagrees. MPEP 2141.01(a) (and established case law) provide as follows:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. \*\*>"Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, \_\_\_\_, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.

Applicant respectfully submits that, using an as a whole inquiry, one having ordinary skill in the art would not have combined *Norwood* with *Payton*, except with the benefit of **improper** hindsight reasoning. *Payton* appears to be concerned with off-loading on-demand bandwidth by downloading content in anticipation of desired on demand content. *Norwood*, on the other hand, appears merely to be concerned with monitoring the logical space of one or more disks coupled to a computer. In other words, each deals with separate matters, and addresses distinct problems. In addition, each is in a separate field of endeavor. Further, one questions

how solving a problem of making efficient use of remotely stored content in a subscriber environment comprising DHCTs of varying storage capacity and performance, as would be one of many problems Applicant's current claim 39 addresses, would combine such disparate systems as *Payton* and *Norwood*. Without the benefit of **improper** hindsight reasoning, it is respectfully submitted that such a combination would not take place. For at least these additional reasons, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

Further, the Office Action alleges that *Tsukidate* remedies the deficiencies of *Payton* and *Norwood* with respect to the retrieval and storage of EPG information on the basis of whether a storage device is coupled or not. It is noteworthy that the Office Action omits an essential feature in that analysis pertaining to *Tsukidate*, which is the involvement of the **dual mode file system**. Also, there is no disclosure of the condition where the storage device is uncoupled. Indeed, *Tsukidate* appears to rely in its principle of operation on the use of the storage (where less than the full amount stored in the disk is extracted to provide an immediate screen without having to wait for the complete reception of the data), so using *Tsukidate* for the claimed features pertaining to the uncoupled storage device is technically unsound, unsupported, and hence unreasonable.

Additionally, none of the references disclose the **audio clips** as claimed.

For at least the reasons presented above, Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 39 is allowable over *Payton* in view of *Norwood*, *Tsukidate*, *Schein*, and *Ellis*, dependent claims 5-18, 23, 24, 27-30, 32-38, 40-44, 46-48, and 57 are allowable as a matter of law for at least the reason that the dependent claims 5-18, 23, 24, 27-30, 32-38, 40-44, 46-48, and 57 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

## Independent Claim 95

Claim 95 recites (with emphasis added):

95. A method in a digital home communication terminal (DHCT) comprising the steps of:  
**determining whether a local storage device is coupled to the DHCT;**  
**retrieving electronic programming guide (EPG) information from a remotely located storage device, through a dual mode file system that provides a common interface to both the remotely located storage device and the local storage device;**  
**responsive to determining that the local storage device is not coupled to the DHCT, storing the EPG information in a memory residing in the DHCT, through a dual mode file system;**  
**responsive to determining that the local storage device is coupled to the DHCT, storing at least a portion of the EPG information in the local storage device, through a dual mode file system;** and  
**presenting the EPG information** responsive to a user request;  
wherein the electronic programming guide information includes a list of media content instances for a standard amount of days, a list of media content instances for an extended amount of days, channels for the media content instances, standard description information for the media content instances, long description information for the media content instances, and media content instance preview **audio** and video **clips**.

Applicant respectfully submits that *Payton* in view of *Norwood*, *Tsukidate*, *Schein*, and *Ellis* fails to disclose, teach, or suggest at least the above-emphasized features. The Office Action (page 4) alleges that *Payton* discloses in col. 6, lines 20-36 an EPG application that provides user access to EPG information. Applicant respectfully disagrees. *Payton* appears to disclose on demand systems (see, e.g., col. 1, lines 38-42, *Payton*). Presumably the Office is referring to the lists 44, but such a list is not disclosed as **EPG information**, and more reasonably refers to on demand content. For at least this reason, Applicant respectfully requests that the rejection be withdrawn.

Additionally, the Office Action (page 4) alleges that the claimed **dual mode file system** is disclosed in col. 7, lines 13-20 and lines 47-55 of *Payton*). Applicant respectfully disagrees. The Office presumably is referring to the local server 28 as the claimed **dual mode file system**,

but such a construction is misplaced, since claim 39 recites a **DHCT** (which the Office has equated to the server 28), and the claimed DHCT comprises various components, including the claimed **dual mode file system**. The server 28 cannot be both. Accordingly, Applicant respectfully requests that the rejection be withdrawn for this additional reason. Alternatively, if Applicant has not accurately determined which component the Office action is equating to the claimed **dual mode file system**, Applicant respectfully requests that the next Office Action specify with particularity which component is being equated to the **dual mode file system**. It is respectfully submitted that it is not inherent that the same component in the server 28 is performing both functions.

Further, since there is no EPG information disclosed in *Payton*, it cannot be accurately asserted that EPG information is presented, and accordingly, Applicant respectfully requests that the rejection be withdrawn for this additional reason.

The Office Action (page 4) acknowledges the deficiencies of *Payton*, but alleges that these deficiencies are remedies by the other references. Applicant respectfully disagrees. For instance, *Norwood* is cited as analogous art. Applicant respectfully disagrees. MPEP 2141.01(a) (and established case law) provide as follows:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. \*\*>"Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.

Applicant respectfully submits that, using an as a whole inquiry, one having ordinary skill in the art would not have combined *Norwood* with *Payton*, except with the benefit of improper hindsight reasoning. *Payton* appears to be concerned with off-loading on-demand bandwidth by

downloading content in anticipation of desired on demand content. *Norwood*, on the other hand, appears merely to be concerned with monitoring the logical space of one or more disks coupled to a computer. In other words, each deals with separate matters, and addresses distinct problems. In addition, each is in a separate field of endeavor. Further, one questions how solving a problem of making efficient use of remotely stored content in a subscriber environment comprising DHCTs of varying storage capacity and performance, as would be one of many problems Applicant's current claim 39 addresses, would combine such disparate systems as *Payton* and *Norwood*. Without the benefit of **improper** hindsight reasoning, it is respectfully submitted that such a combination would not take place. For at least these additional reasons, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

Further, the Office Action alleges that *Tsukidate* remedies the deficiencies of *Payton* and *Norwood* with respect to the retrieval and storage of EPG information on the basis of whether a storage device is coupled or not. It is noteworthy that the Office Action omits an essential feature in that analysis pertaining to *Tsukidate*, which is the involvement of the **dual mode file system**. Also, there is no disclosure of the condition where the storage device is uncoupled. Indeed, *Tsukidate* appears to rely in its principle of operation on the use of the storage (where less than the full amount stored in the disk is extracted to provide an immediate screen without having to wait for the complete reception of the data), so using *Tsukidate* for the claimed features pertaining to the uncoupled storage device is technically unsound, unsupported, and hence unreasonable.

Additionally, none of the references disclose the **audio clips** as claimed.

For at least the reasons presented above, Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 95 is allowable over *Payton* in view of *Norwood*, *Tsukidate*, *Schein*, and *Ellis*, dependent claims 96-101 are allowable as a matter of law.



## Independent Claim 129

Claim 129 recites (with emphasis added):

129. A computer-readable medium having a program stored thereon for execution in a digital home communication terminal (DHCT) comprising the steps of:

**logic configured to determine whether a local storage device is coupled to the DHCT;**

**logic configured to retrieve electronic programming guide (EPG) information from a remotely located storage device, through a dual mode file system that provides a common interface to both the remotely located storage device and the local storage device;**

**logic configured to store the EPG information in a memory residing in the DHCT, through a dual mode file system, responsive to the determination that the local storage device is not coupled to the DHCT;**

**logic configured to store at least a portion of the EPG information in the local storage device, through a dual mode file system, responsive to the determination that the local storage device is coupled to the DHCT;** and

logic configured to **present the EPG information** responsive to a user request;

wherein the EPG information includes a list of media content instances for a standard amount of days, a list of media content instances for an extended amount of days, channels for the media content instances, standard description information for the media content instances, long description information for the media content instances, and media content instance preview **audio** and video **clips**.

Applicant respectfully submits that *Payton* in view of *Norwood*, *Tsukidate*, *Schein*, and *Ellis* fails to disclose, teach, or suggest at least the above-emphasized features. The Office Action (page 4) alleges that *Payton* discloses in col. 6, lines 20-36 an EPG application that provides user access to EPG information. Applicant respectfully disagrees. *Payton* appears to disclose on demand systems (see, e.g., col. 1, lines 38-42, *Payton*). Presumably the Office is referring to the lists 44, but such a list is not disclosed as **EPG information**, and more reasonably refers to on demand content. For at least this reason, Applicant respectfully requests that the rejection be withdrawn.

Additionally, the Office Action (page 4) alleges that the claimed **dual mode file system** is disclosed in col. 7, lines 13-20 and lines 47-55 of *Payton*). Applicant respectfully disagrees.

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Applicant respectfully submits that, using an as a whole inquiry, one having ordinary skill in the art would not have combined *Norwood* with *Payton*, except with the benefit of improper

hindsight reasoning. *Payton* appears to be concerned with off-loading on-demand bandwidth by downloading content in anticipation of desired on demand content. *Norwood*, on the other hand, appears merely to be concerned with monitoring the logical space of one or more disks coupled to a computer. In other words, each deals with separate matters, and addresses distinct problems. In addition, each is in a separate field of endeavor. Further, one questions how solving a problem of making efficient use of remotely stored content in a subscriber environment comprising DHCTs of varying storage capacity and performance, as would be one of many problems Applicant's current claim 39 addresses, would combine such disparate systems as *Payton* and *Norwood*. Without the benefit of **improper** hindsight reasoning, it is respectfully submitted that such a combination would not take place. For at least these additional reasons, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

Further, the Office Action alleges that *Tsukidate* remedies the deficiencies of *Payton* and *Norwood* with respect to the retrieval and storage of EPG information on the basis of whether a storage device is coupled or not. It is noteworthy that the Office Action omits an essential feature in that analysis pertaining to *Tsukidate*, which is the involvement of the **dual mode file system**. Also, there is no disclosure of the condition where the storage device is uncoupled. Indeed, *Tsukidate* appears to rely in its principle of operation on the use of the storage (where less than the full amount stored in the disk is extracted to provide an immediate screen without having to wait for the complete reception of the data), so using *Tsukidate* for the claimed features pertaining to the uncoupled storage device is technically unsound, unsupported, and hence unreasonable.

Additionally, none of the references disclose the **audio clips** as claimed.

For at least the reasons presented above, Applicant respectfully requests that the rejection be withdrawn.

Claims 49-51 and 53-57 -*Payton, Norwood, Tsukidate, Schein, and Ellis, and Dougherty*

As set forth above, *Payton, Norwood, Tsukidate, Schein, and Ellis* fails to disclose, teach, or suggest at least the features emphasized above in independent claim 39. Applicant respectfully submits that *Dougherty* does not remedy the deficiencies of the other cited art references. For at least the reason that claim 39 is allowable over *Payton, Norwood, Tsukidate, Schein, and Ellis, and Dougherty*, Applicant respectfully submits that claims 49-51 and 53-57 are allowable as a matter of law. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Claims 15, 23-30, 32-38, and 48 - *Payton, Norwood, Tsukidate, Schein, and Ellis, and Daniels*

As set forth above, *Payton, Norwood, Tsukidate, Schein, and Ellis* fails to disclose, teach, or suggest at least the features emphasized above in independent claim 39. Applicant respectfully submits that *Daniels* does not remedy the deficiencies of the other cited art references. For at least the reason that claim 39 is allowable over *Payton, Norwood, Tsukidate, Schein, and Ellis, and Daniels*, Applicant respectfully submits that claims 15, 23-30, 32-38, and 48 are allowable as a matter of law. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Claim 130 - *Tsukidate* in view of *Norwood*.

Claim 130 recites (with emphasis added):

130. A dual mode file method in a digital home communication terminal (DHCT) comprising the steps of:  
***determining whether a local storage device is coupled to the DHCT; responsive to determining that the local storage device is not coupled to the DHCT, retrieving, from a remotely located virtual file system, first electronic programming guide (EPG) information and storing the first EPG information in a memory residing in the DHCT; the first EPG information including a list of media content instances for only a standard number of days, and***  
***responsive to determining that the local storage device is coupled to the DHCT, retrieving, from the remotely located virtual file system, first and second electronic programming guide (EPG) information and storing the first EPG information in a memory residing in the DHCT and the second EPG information in the local storage device; the second EPG information including a list of media content instances for an extended number of days, and***  
presenting the EPG information responsive to a user request.

Applicant respectfully submits that *Tsukidate* in view of *Norwood* fails to disclose, teach, or suggest at least the above-emphasized features. *Norwood* is improperly combined with *Tsukidate*, especially in view of the fact that having a storage device appears to be central to *Tsukidate*, and hence operation is premised on having the storage device. To combine *Norwood* with *Tsukidate* appears to be based on improper hindsight reasoning, since *Norwood* is not analogous art and not a reference one would reasonably combine with *Tsukidate* when taking an as a whole approach as required. Indeed, *Tsukidate* appears to focus on addressing delay in populating information on a screen without waiting for a complete download, which has nothing to do with the teachings of *Norwood*.

Additionally, *Tsukidate* does not appear to store the retrieved EPG information from a remote location to memory. On the contrary, that which is stored in memory appears to be the result of a process performed on content received to the storage device (see, e.g., columns 13-14, *Tsukidate*).

Further, none of the store operations of *Tsukidate* are the result of a determination of the existence of a coupled storage device, since, as explained above, the disclosure of *Tsukidate* appears to be premised on the existence of a storage device for proper operation. Accordingly, it is not obvious to combine *Tsukidate* with *Norwood* for at least the reason of differences in operation, and disparity of systems. Accordingly, for at least these reasons, Applicant respectfully requests that the rejection be withdrawn.

**CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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